UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,363	03/17/2000	Mason Ng	40827.00039	4258

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EXAMINER
LIN, KENNY S

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 October 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-8</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-8</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-8 are presented for examination.

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 10/14/2005 has been entered. An action on the

RCE follows.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

4.   Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Narasimhan et al

(hereinafter Narasimhan), US Patent 6,073,165.

5.   Narasimhan was cited in the previous office action.

6.   As per claims 3-4, Narasimhan taught the claimed invention including a method,

comprising:

   a. Establishing a communication channel with a client computer system using an

      HTTP port (col.1, lines 40-43, col.2, lines 50-65, col.3, lines 39-44);

   b. Receiving information corresponding to new email events from the client

      computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and

   c. Storing the information corresponding to the new email events in a database

      (col.4, lines 6-11, col.6, lines 11-21, 40-56).

7.   As per claims 5-6, Narasimhan taught the claimed invention including a method at a

client computer system comprising:

   a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

   b. Examining email data against the filter control data (col.5, lines 3-17);

   c. Determine the email data that will be forwarded based on the examination (col.56,

      lines 3-17);

d. Selecting at least one transfer protocol for the email data based on the

examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45); and

e. Forwarding the email data according to the at least one transfer protocol via a

computer network to a database (col.6, lines 19-21, 40-56).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al

(hereinafter Chen), US Patent 6,510,455, in view of Paarsmarkt et al (hereinafter Paarsmarkt),

US Patent 6,118,856, Narasimhan et al (hereinafter Narasimhan), US Patent 6,073,165, and

Bastian et al (hereinafter Bastian), US Patent 6,757,712.

10.   Chen, Paarsmarkt and Narasimhan were cited in the previous office action.

11.   As per claims 1-2, Chen taught the invention substantially as claimed including a method,

comprising:

a. examining start criteria (col.6, lines 12-22);

  b. determining whether the start criteria have been met (col.6, lines 12-22, 25-31);
and

  c. obtaining new email events from an email database after the start criteria have
been met (col.6, lines 25-52).

12. Chen did not specifically teach the method to forward information corresponding to the
new email events via a computer network to a database using an HTTP port. However,
Paarsmarkt taught an email system to forward information or portion of information
corresponding to the new email events via a computer network (col.2, lines 1-4, 15-17, 25-29,
48-52). It would have been obvious to one of ordinary skill in the art at the time the invention
was made to combine the teachings of Chen and Paarsmarkt because Paarsmarkt's teaching of
forwarding information or portion of information enables users to specify condition for
forwarding received email to a remote device in Chen's email system and provide Chen's email
system selective forwarding benefits (see Paarsmarkt, col.2, lines 1-4, 48-52). Chen and
Paarsmarkt did not specifically teach to forward information to a database using an HTTP port.
Narasimhan taught to store the information into database (col.4, lines 6-11, col.6, lines 11-21,
40-56) and HTTP protocol communication (col.3, lines 39-44). It would have been obvious to
one of ordinary skill in the art at the time the invention was made to combine the teachings of
Chen, Paarsmarkt and Narasimhan because Narasimhan's teaching of storing the forwarded
information in a database enables subsequent recall of information from the database (see
Narasimhan, col.6, lines 11-21). Chen, Paarsmarkt and Narasimhan did not specifically teach to
forward information using and HTTP port. Bastian taught to forward information using HTTP

port (col.13, lines 59-65, col.14, lines 35-51; forwarding using HTTP protocol or other suitable

protocol). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine the teachings of Chen, Paarsmarkt, Narasimhan and Bastian because

Bastian's teaching of using suitable protocols for forwarding information enables Chen,

Paarsmarkt and Narasimhan's system to forward information using HTTP or any other suitable

protocols (see Bastian, col.13, lines 59-65, col.14, lines 38-51).

13.   Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et

al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US

Patent 6,138,146, and Bastian et al (hereinafter Bastian), US Patent 6,757,712.

14.   Moon was cited in the previous office action.

15.   As per claims 7-8, Narasimhan taught the invention substantially as claimed including a

method, comprising:

      a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

      b. Examining email data against the filter control data (col.5, lines 3-17); and

      c. Determining based on the examination the email data that should not be

         forwarded (col.2, lines 3-6, col.5, lines 3-23);

      d. Generating receipt data identifying the email data that should be forwarded (col.1,

         lines 46-51, col.4, lines 6-11, col.6, lines 11-18); and

     e. Forwarding the receipt data via a computer network to a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).

16.   Narasimhan did not specifically teach the step of generating receipt data identifying the email data that <u>should not be</u> forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that <u>should be</u> forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded. Moon taught to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block. Narasimhan and Moon did not specifically teach to forward information using and HTTP port. Bastian taught to forward information using HTTP port (col.13, lines 59-65, col.14, lines 35-51; forwarding using HTTP protocol or other suitable protocol). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan, Moon and Bastian because Bastian's teaching of using suitable protocols for forwarding information enables Narasimhan and Moon's system to forward information using HTTP or any other suitable protocols (see Bastian, col.13, lines 59-65, col.14, lines 38-51).

Response to Arguments

17.   Applicant's amendment with respect to claims 1-2 and 7-8 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

    Gottlieb, US 6,446,118.

    Masters, US 6,374,300.

    Baker et al, US 6,956,845.

    Guedalia et al, US 6,907,112.

19.   A shortened statutory period for reply to this Office action is set to expire THREE

MONTHS from the mailing date of this action.

20.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The

examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
November 28, 2005